

REMARKS***Summary of the Response***

By the present response, claims 39 – 42, directed to the non-elected inventions, and independent claim 43 will have been canceled without prejudice or disclaimer. However, Applicants expressly reserve the right to refile the subject matter of claims 39 – 43 in one or more continuing applications. Accordingly, only claims 18 – 25, 27, 28 and 30 – 38 are currently pending.

Summary of the Office Action

In the instant Office Action, the Examiner has indicated that claims 18 – 25, 27, 28, and 30 – 38 are allowed, but has rejected claim 43 based upon formal matters and over the art of record. By the present amendment and remarks, Applicants submit that the rejections are now moot, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Amendment is Proper for Entry

As the pending amendment merely cancels claims, Applicants submit that entry is proper after final rejection. In particular, as claims 39 – 42, which are directed to non-elected inventions not under consideration by the Examiner, and independent claim 43, which has no claims depending therefrom, have been canceled without prejudice or disclaimer, Applicants submit that no new issues requiring further search or consideration nor any question of new matter are raised in entering the pending amendment.

Accordingly, entry and consideration of the pending amendment is requested and allowance of the application is proper.

Acknowledgment of Allowed Claims

Applicants gratefully acknowledge and agree with the Examiner's determination that claims 18 – 25, 27, 28, and 30 – 38 are allowed. Moreover, as the allowed claims are the only claims remaining in the pending application, Applicants request a Notice of Allowance in the next official communication from the Examiner.

Rejection Under 35 U.S.C. § 112, First Paragraph, is Moot

Applicants submit that the formal rejection of claim 43 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is moot.

While Applicants do not agree that the original disclosure does not reasonably convey to one ordinarily skilled in the art that the inventors had possession of the invention including the recited metering rod structured and arranged to doctor off excess coating color and to calibrate a thickness of the web, Applicants have canceled independent claim 43 without prejudice or disclaimer, but have expressly reserved the right to refile the subject matter of this claim in one or more continuing applications.

Accordingly, Applicants request that the Examiner reconsider and withdraw the formal rejection of claim 43 under 35 U.S.C. § 112, first paragraph.

Rejection Under 35 U.S.C. § 112, Second Paragraph, is Moot

Applicants submit that the formal rejection of claims 43 under 35 U.S.C. § 112, second paragraph, as being indefinite is moot.

While Applicants do not agree that the term metering rod structured and arranged to doctor off excess coating color and to calibrate a thickness of the web is unclear or that one ordinarily skilled in the art reviewing the specification and claims would not be able to understand the metes and bounds of the claims using the term metering rod structured and

arranged to doctor off excess coating color and to calibrate a thickness of the web, in an effort to advance prosecution, Applicants have canceled independent claim 43 without prejudice or disclaimer, but with an express reservation to refile the subject matter of this claim in one or more continuing applications.

Accordingly, Applicants request that the Examiner reconsider and withdraw the formal rejection of claim 43 under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 103(a) is Moot

Applicants submit the rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over AHONEN et al. (U.S. Patent No. 6,413,371) [hereinafter "AHONEN"] with or without LEYRER (U.S. Patent No. 6,964,993) or ANDERSON (U.S. Patent No. 5,766,525) is moot.

While Applicants do not acquiesce that the subject matter of claim 43 is rendered unpatentable under any proper interpretation and modification of AHONEN with or without LEYRER or ANDERSON, in an effort to advance prosecution, Applicants have canceled independent claim 43 without prejudice or disclaimer, but with an express reservation to refile the subject matter of this claim in one or more continuing applications.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 43 under 35 U.S.C. § 103(a).

Application is Allowable

In view of the foregoing, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

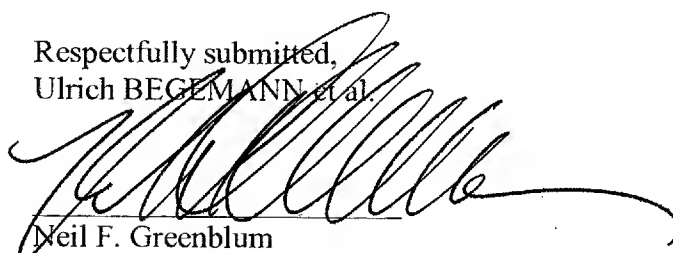
CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicants' invention, as recited in claims 18 - 25, 27, 28 and 30 - 38. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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